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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,264	11/12/1999	KUNIHICO MIWA	JA9-98-171	1450
26582	7590	02/13/2004	EXAMINER	
HOLLAND & HART, LLP 555 17TH STREET, SUITE 3200 DENVER, CO 80201			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER

3621

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/439,264

Applicant(s)

MIWA ET AL.

Examiner

Firmin Backer

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24, 27-29 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24, 27-29 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

Response to Amendment

This is in response to an amendment file on January 7th, 2004. In the amendment, claims 23-24, 27 and 32 have been amended, no claim has been canceled, and no claim has been added.

Claims 21-24, 27-29, 32-34 remain pending in the letter.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 21-24, 27-29 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa et al (U.S. Patent No. 6,230,268) in view of Ueda et al (U.S. Patent No. 6,289,102).

3. As per claim 21, Miwa et al teach a method of recording digital data onto a medium comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark is electronically embedded in the digital data through a transformation of the digital data and if the watermark is detected, then performing access control for the digital data using the watermark (*see abstract, column 2 lines 35-3 line 16, 3 lines 41-55*). Miwa et al fail to teach an inventive concept of scrambling the digital data with digital watermark, and recording the scrambled digital data with digital watermark onto a medium. However, Ueda et al teach an inventive concept of scrambling the digital data with

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digital watermark, and recording the scrambled digital data with digital watermark onto a medium (*see abstract, column 2 lines 43-52, 3 lines 52-59*). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive concept to include Ueda et al's of scrambling the digital data with digital watermark, and recording the scrambled digital data with digital watermark onto a medium because this would have ensured the prevention of the content recorded in the information recording medium from being illegally copied so as to realize secured copyright protection.

4. As per claim 22, Miwa et al teach a method of determining whether copying/recording of the digital data is to be stopped or continued (*column 4 lines 10-39*).

5. As per claim 23, Miwa et al teach a method further comprises embedding a copy mark into the digital data in accordance with a content of the digital watermark (*see abstract, column 2 lines 35-3 line16, 3 lines 41-55*).

6. As per claim 24, Miwa et al teach a method of recording digital data onto a medium comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark and a copy mark that is electronically embedded in the digital data through a transformation or the digital data and if the watermark is detected, then performing playback control for the descrambled digital data using the watermark and the copy mark (*see abstract, column 2 lines 35-3 line16, 3 lines 41-55*). Miwa et al fail to teach an inventive concept reading a scrambled digital data from the medium and descrambling the

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scrambled digital data read from the medium. However, Ueda et al teach an inventive concept of reading a scrambled digital data from the medium and descrambling the scrambled digital data read from the medium (*see abstract, column 4 lines 25-34, 53-65*). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive concept to include Ueda et al's of reading a scrambled digital data from the medium and descrambling the scrambled digital data read from the medium because this would have ensured the prevention of the content recorded in the information recording medium from being illegally copied so as to realize secured copyright protection.

7. As per claim 27 and 32, Miwa et al teach a video driver comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark and a copy mark that is electronically embedded in the digital data through a transformation of the digital data and if the watermark is detected, then performing playback control for the descrambled digital data using the watermark and the copy mark (*see abstract, column 2 lines 35-3 line 16, 3 lines 41-55*). Miwa et al fail to teach an inventive concept for decoding a scrambled digital data and descrambling the scrambled digital data. However, Ueda et al teach an inventive concept of for decoding a scrambled digital data and descrambling the scrambled digital data (*see abstract, column 4 lines 25-34, 53-65*). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive concept to include Ueda et al's of for decoding a scrambled digital data and descrambling the scrambled digital data because this would have ensured the prevention of the content recorded in

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the information recording medium from being illegally copied so as to realize secured copyright protection.

8. As per claim 28, 29, 33 and 34, Miwa et al teach a video driver card wherein the scrambling digital data is an MPEG stream, and determining whether or not to output the MPEG stream and adding a copy mark to the MPEG stream (*see fig 4, column 5 lines 41-63, 6 lines 18-49*).

Response to Arguments

9. Applicant's arguments filed September 5, 2003 have been fully considered but they are not persuasive.

a. Applicant amended the claims 21, 24, 27 and 32 by adding a common key used for encrypting, coding and scrambling digital data and decrypting, decoding and descrambling digital data. Applicant argues that the prior art fail to teach and common key for encrypting, coding and scrambling digital data and decrypting, decoding and descrambling digital data. Examiner respectfully disagrees with applicant characterization of the prior arts. Ueda et al teach a system wherein the information reproducing device uses the table recorded in the scramble information sector and the key for the scrambling that descramble processing can be performed. A seed key field where the key used at the time of scrambling (hereinafter, referred to as a seed key) is recorded, and a use identifying information field where information for identifying use of the file is

recorded. In the scramble flag field is recorded value 1 indicating that scramble-processing has been performed. In the seed key field is recorded a key to be used for descramble-processing for the main data field. Furthermore, in the use identifying information field is recorded information on the use of the recorded data such as industrial use or consumer use, and is recorded information indicating a reproduction restriction in the case where the use of the information reproducing device is different from the use identifying information. Furthermore, in the main data field is recorded data having been subjected to the scramble-processing determined by a scramble system specified by the scramble information sector in the lead-in area and the seed key in the sector header field in the scrambled sector. More specifically, a preset data is determined based on the value recorded in the seed key field and referring to the table in the scramble information sector. Then, by using the random number sequence determined by the preset data, scrambled/descramble-processing is possible. In the following description, the seed key is the same for every file (*see column 15 line 22-59*). Moreover, the concept of using the same key for encryption and coding is known as symmetric key cryptography process and is well known in the cryptographic art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

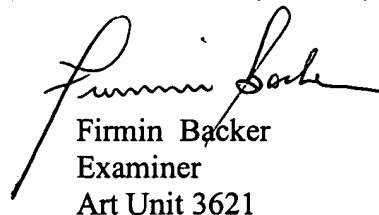
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Firmin Backer
Examiner
Art Unit 3621

February 10, 2004